

## **REMARKS**

Claims 13-41 were canceled. Claims 42-53 were added. Claim 1 was amended.

Applicants believe the amendments to claim 1 do not diminish the previous grounds for allowability. Claims 42-45 are allowable for at least the reason that they depend from allowable claim 1. Applicants also respectfully request that claims 4-9 be rejoined as they depend from an allowable generic claim.

Newly added claims 46-53 are allowable for reasons similar to those accepted for claim 1. Canceled claims 13-23 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. New apparatus claims 46-52 do not include elements that could be construed as humans. The scanner, collector, and comparator are directed to hardware components.

Claims 13, 14, and 22 were rejected under 35 U.S.C. § 102 as allegedly being anticipated by U.S. Patent No. 6,439,345 (Recktenwald). Claim 15 was rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Recktenwald in view of U.S. Patent No. 6,323,782 (Stephens). Claim 23 was rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Recktenwald in view of U.S. Patent No. 6,069,969 (Keagy).

The Office Action argued that the collector of Recktenwald that collects user name or telephone number equates to a collector that collects biometric information. The collector of Recktenwald is simply an input device such as a keyboard or touch screen. Such a device is incapable of collecting biometric data. A biometric data collector is structurally much different than an input device for receiving a user's name. By definition, a biometric data collector captures physical characteristic data that is unique to the individual from which the data is collected. The collector of Recktenwald is incapable of discriminating between two different individuals that might provide a user name or phone number. The Office Action argues that the

biometric data is associated with the intended use of the apparatus, not its structure. Applicants respectfully disagree. The structure of a collector of biometric data is entirely different than a collector of alphanumeric data.

As the Examiner well knows, an anticipating reference by definition must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. *In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). To the extent the Examiner relies on principles of inherency in making the anticipation rejections in the Office Action, inherency requires that the asserted proposition necessarily flow from the disclosure. *In re Oelrich*, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981); *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1463-64 (Bd. Pat. App. & Int. 1990); *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Int. 1987); *In re King*, 231 U.S.P.Q. 136, 138 (Fed. Cir. 1986). It is not enough that a reference could have, should have, or would have been used as the claimed invention. “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Oelrich*, at 326, quoting *Hansgird v. Kemmer*, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939); *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993), quoting *Oelrich*, at 326; see also *Skinner*, at 1789. “Inherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Skinner*, at 1789, citing *Oelrich*. Where anticipation is found through inherency, the Office’s burden of establishing prima facie anticipation includes the burden of providing “...some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Skinner* at 1789.

It does not necessarily flow that the collector of Recktenwald is capable of collecting biometric data. Name and phone number data is not biometric data, and a collector capable of

collecting biometric data is structurally different than a collector for gathering name or phone number data. For these reasons, claims 46-52 are allowable over Recktenwald.

In view of the foregoing, Applicants respectfully submit that all pending claims are in condition for allowance. The Examiner is invited to contact the undersigned at (713) 934-4070 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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